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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/578,946	02/05/2007	John Santa Lucia	DNASOFT-10963	5250
72960	7590	12/21/2010	EXAMINER	
Casimir Jones, S.C.			DEJONG, ERIC S	
2275 DEMING WAY, SUITE 310			ART UNIT	
MIDDLETON, WI 53562			PAPER NUMBER	
			1631	
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			12/21/2010	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/578,946

**Applicant(s)**

SANTALUCIA ET AL.

**Examiner**

ERIC S. DEJONG

**Art Unit**

1631

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 October 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 3-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 May 2006 is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-945)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 04/08/2010
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED OFFICE ACTION**

Applicants response filed 10/14/2010 is acknowledged.

### ***Election/Restrictions***

Applicant's election without traverse of Group II (claims 3-6) in the reply filed on 10/14/2010 is acknowledged.

Claims 1, 2, and 7-10 have been cancelled by applicant. Claims 3-6 are pending and currently under examination.

### ***Information Disclosure Statement***

The information disclosure statements (IDS) submitted on 4/28/2010 have been considered by the examiner.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 4 and 6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the instant case, claim 4 depends directly from claim 3. Similarly, Claim 6 depends directly from claim 5. Claim 3 and 5 are each directed to an apparatus.

Confusingly, claims 4 and 6 recite process limitation directed to a step of submitting a test sequence to the apparatus of set forth in claims 3 and 5, respectively. This causes the metes and bounds of claims 4 and 6 to be indefinite because the dependent claims do not further limit the apparatus that is set forth in either claim 3 or 5, respectively, and, further, recite limitations that are directed to another statutory category of invention (a process) as opposed to limitations that are directed to the category of invention set forth in all independent claims (an apparatus). For these reasons, claims 4 and 6 are indefinite.

For the benefit of applicants, the examiner recommends that applicant amend claims 4 and 6 to be independent process claims that do not depend from either of claim 3 or 5, respectively.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Floudas et al. (US Patent No 6,832,162) in view of Maier et al. (Eur Biophys K Biophys LETT (1999), see citation #27 of IDS filed 04/28/2010).

In the instant case, the claimed invention is directed to a system for predicting nucleic acid three dimensional structure comprising a configured processor. The

processor is configured to computer a plurality of secondary structures of a test nucleic acid, decompose said secondary structures into nucleic acid structure motifs, ranking said motifs into a hierarchal tree, identifying candidate three-dimensional motif structures from a database, linking said structural motifs to generate a candidate three-dimensional composite structure, refining said composite structures using an energy minimizing algorithm, ranking one or more candidate structures based on calculated energy and (optionally) by one or more scoring parameters based on of solvent accessible surface area, molecular density, and non-bonded energy, and selecting a refined candidate based on best calculated energy. Further, claim 5 is directed to a system comprising a configured processor for generating a nucleic acid structural motif database comprising only the steps of receiving nucleic acid physical structure information, decomposing said information into nucleic acid structural motifs, associating the data with said structure motifs, comparing structures to existing motifs in said database, and adding sad structure to said database.

Floudas et al. is sets forth the method and related systems of an *ab initio* prediction of  $\alpha$  helices,  $\beta$  sheets, and polypeptide structures (see Abstract). The disclosed *ab initio* prediction approach involves 4 stages (See Figure 1 and col. 2, line 20 through col. 6, line 21). The first and second stages of the approach involve partitioning of the amino acid sequence of a protein of interest into a plurality of oligopeptides followed by the computation of secondary structure motifs therefrom (see col. 2, lines 20-60 and col. 11, lines 17-57). Floudas et al. further teaches, regarding the prediction of the folded state of a protein and how the formation of secondary structure

and tertiary structure proceeds (see col. 5, line 61 through col. Col. 6, line 11), the classical approach of hierarchical folding, wherein secondary structural elements form rapidly followed by the slower arrangement of the tertiary fold. Floudas et al. further teaches that this approach is relied upon for the generation of  $\alpha$ -helical secondary structure motifs (see col. 6, lines 3-11). Floudas et al. further teaches that the identification the three dimensional structure of secondary structure motifs based on the three-dimensional structures and properties of  $\alpha$ -helices,  $\beta$ -sheets, and other known secondary structures common in protein structure (see col. 4, line 66 through col.5, line 10). Floudas et al. further teaches the linking of candidate secondary structures, using a hierarchal approach, to generate composite three dimensional structures by use of global optimization framework based on energy minimization (see col. 5, line 11 through col. 6, line 11).

While Floudas et al. teaches the above *ab initio* approach to the prediction of three-dimensional protein structure based on hierarchal linking of the tertiary structure of protein secondary motifs, Floudas et al. does not expressly teach or suggest the application of the *ab initio* prediction approach to the prediction of nucleic acid tertiary structures based on hierarchal linking of the tertiary structure of nucleic acid secondary motifs.

Maier et al. is relied upon for teaching that the use of conformational search methods used to predict biomolecular structure, encompass application to both protein and nucleic acid structure (see Maier et al., page 565, col. 1, lines 25-59). Maier et al. further teaches that the progress achieved in the predicting biomolecular structure is

documented by successful applications to searching conformational space of oligopeptides (non-nucleic acids). Maier et al. further teaches that the remarkable intrinsic stability of certain classes of RNA structural motifs play an important role in the tertiary folding of RNA molecules and the emerging "tool-kit" of RNA structural motifs is expected to substantially aid in the in the model building of RNA 3D structures (see Maier et al., page 565, lines 1-24).

Therefore it would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains to modify the *ab initio* modeling approach to prediction of protein three dimensional structure prediction, as taught by Floudas et al., to accommodate the prediction of nucleic acid three dimensional computing and identifying the three dimensional structure of nucleic acid secondary structure motifs, as taught by Maier et al., in place of the three dimensional structure of protein secondary structure motifs. On of ordinary skill in the art would recognize from the teachings of Maier et al. that computational modeling and prediction approaches of biomolecules can accommodate either nucleic acid and protein structures. Further one of skill in the art would rely upon the teachings of Maier et al. in the computation, ranking and identification of nucleic acid secondary structural motifs and their three dimensional structure.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ERIC S. DEJONG whose telephone number is (571)272-6099. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Marjorie Moran can be reached on (571) 272-0720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/ERIC S. DEJONG/  
Primary Examiner, Art Unit 1631